

## **IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Serial No.:	10/668,701	Conf. No.:	2190
Filing Date:	23 September 2003	Art Unit:	2625
Applicant:	Stewart et al.	Examiner:	Garcia, Gabriel I.
Title:	System, method and recordable medium for printing services over a network	Docket No.:	MIME-0001-DIV

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

### **BRIEF OF APPELLANTS**

Sir:

This paper is being filed as part of an appeal from the Final Office Action dated 24 August 2009 rejecting claims 24-47 and subsequent Advisory Action dated 23 November 2009 maintaining all rejections. This Brief is accompanied by the requisite fee set forth in 37 C.F.R. 1.17(c).

### **REAL PARTY IN INTEREST**

Mimeo.com, Inc. is the real party in interest.

### **RELATED APPEALS AND INTERFERENCES**

A related application, U.S. Application No. 09/709,433, was previously appealed to the Board of Patent Appeals and Interferences (Appeal 2007-3345) and a decision was rendered by the Board on June 16, 2008.

## **STATUS OF CLAIMS**

As filed, this case included claims 1-23. In a preliminary amendment, claims 1-23 were canceled, and claims 24-43 were added. During prosecution, claims 44-47 were subsequently added. As a result, claims 24-47 are currently pending. Claims 24-47 stand rejected and form the basis of this appeal.

## **STATUS OF AMENDMENTS**

No amendment to the claims has been submitted subsequent to the 24 August 2009 Final Office Action. An after final response that did not amend the claims was filed on 26 October 2009, and was considered and entered by the Examiner.

## **SUMMARY OF CLAIMED SUBJECT MATTER**

In an embodiment, the invention provides for previewing a document over a network, such as the Internet. An embodiment of the invention uses system software, which includes a print driver executing on a client, to generate a print file and manage interaction with a server. In this manner, the preview of a document over a network is integrated into the client application in a manner that is not provided in the prior art.

Claim 24 claims a method of previewing a document, comprising: generating a print file on a client based on the document using a print driver executing on the client in response to a print request for the document designating the print driver (see, e.g., p. 18, lines 17-20; FIG. 7A, ref. 605 and p. 20, lines 1-3, FIG. 9, ref. 506); automatically transmitting the print file over a network for processing by a server in response to the generating without user-initiated interaction with the server (see, e.g., p. 18, lines 20-21;

FIG. 7A, ref. 610, p. 20, lines 3-7, p. 21, lines 5-7; FIG. 9, ref. 532); receiving image data on the client over the network in response to the transmitting, the image data being based on the transmitted print file (see, e.g., p. 15, lines 2-7; FIG. 5, ref. 422); and displaying the image data in an interface at the client in response to the receiving (see, e.g., p. 18, line 20-p. 19, line 3; FIG. 7A, ref. 620).

Claim 32 claims a system for previewing a document, comprising: a generation system for generating a print file based on the document using a print driver executing on a client in response to a print request for the document designating the print driver (see, e.g., FIG. 3, ref. 300a; p. 18, lines 17-20; FIG. 7A, ref. 605 and p. 20, lines 1-3, FIG. 9, ref. 506); and an upload manager for automatically transmitting the print file over a network for processing by a server in response to the generating without user-initiated interaction with the server (see, e.g., FIG. 3, ref. 310c; p. 18, lines 20-21; FIG. 7A, ref. 610, p. 20, lines 3-7, p. 21, lines 5-7; FIG. 9, ref. 532), receiving image data on the client over the network in response to the transmitting, the image data being based on the transmitted print file (see, e.g., p. 15, lines 2-7; FIG. 5, ref. 422), and displaying the image data in an interface at the client in response to the receiving (see, e.g., p. 18, line 20-p. 19, line 3; FIG. 7A, ref. 620).

Claim 36 claims a computer program product comprising a computer useable medium having computer readable program code embodied therein for previewing a document, the program product comprising: program code for receiving a print request for the document (see, e.g., p. 18, lines 17-20; FIG. 7A, ref. 605 and p. 20, lines 1-3, FIG. 9, ref. 506); program code for generating a print file based on the document in response to the receiving (see, e.g., p. 18, lines 17-20; FIG. 7A, ref. 605 and p. 20, lines

1-3, FIG. 9, ref. 506); program code for automatically transmitting the print file over a network for processing by a server in response to the generating without user-initiated interaction with the server (see, e.g., p. 18, lines 20-21; FIG. 7A, ref. 610, p. 20, lines 3-7, p. 21, lines 5-7; FIG. 9, ref. 532); program code for receiving image data on the client over the network in response to the transmitting, the image data being based on the transmitted print file (see, e.g., p. 15, lines 2-7; FIG. 5, ref. 422); and program code for displaying the image data in an interface at the client in response to the receiving (see, e.g., p. 18, line 20-p. 19, line 3; FIG. 7A, ref. 620).

## **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

- I. Rejection of claims 24-47 under 35 USC § 112, first paragraph as allegedly not being enabled by the specification.
- II. Rejection of claims 24-28, 30-39, and 41-47 under 35 USC § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,615,234 (Adamske) in view of U.S. Patent No. 6,134,568 (Tonkin).
- III. Rejection of claims 29 and 40 under 35 USC § 103(a) as allegedly being unpatentable over Adamske in view of Tonkin and in further view of U.S. Patent Application Publication No. 2001/00433753 (Grohs).

## ARGUMENT

### I. Rejection of claims 24-47 under 35 USC § 112, first paragraph

In the Final Office Action, the Examiner rejects claims 24-47 under 35 U.S.C. § 112, first paragraph, because the specification allegedly "does not reasonably provide enablement for generating and transmitting print files and prompting the user without any further user interaction after the request to print." Final Office Action, p. 3.

Appellants traverse these rejections.

Initially, Appellants note that the limitations "prompting the user without any further user interaction after the request to print" cited by the Examiner are not in any of the claims. As a result, Appellants respectfully submit that the rejection is defective.

Additionally, with respect to claim 24, Appellants note that several portions of the specification and figures describe generating a print file and automatically transmitting the print file to a server without user-initiated interaction with the server as claimed therein. See, e.g., specification, p. 18 and Fig. 7, 605, 610; and pp. 20-21 and Fig. 9, 506, 532.

Furthermore, the Examiner cites page 23, lines 9-14 of the specification as allegedly discussing "that a user would have to manually log in to the system between the steps of generation and transmission." Final Office Action, p. 3. However, Appellants note that the specification includes only 22 pages.

Regardless, even if, *arguendo*, entry of user credentials or verification of stored user credentials via a sign in screen comprises user interaction, Appellants note that this type of user interaction is not initiated by the user. In contrast, a server transmits a sign in screen for authentication, and therefore initiates the interaction. To this extent,

Appellants submit that one skilled in the art is readily enabled by the specification to make and use a method of previewing a document in which a print file is generated in response to a print request and automatically transmitted over a network for processing by a server without user-initiated interaction with the server as in claim 24.

Appellants note that the specification includes similar support for the system of claim 32 and the computer program product of claim 36. In light of the above, Appellants respectfully request reversal of the rejection to claims 24-47 as allegedly not being enabled by the specification.

## **II. Rejection of claims 24-28, 30-39, and 41-47 under 35 USC § 103(a)**

The Examiner rejects claims 24-28, 30-39, and 41-47 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,615,234 (Adamske) in view of U.S. Patent No. 6,134,568 (Tonkin). Appellants respectfully submit that the Examiner fails, *inter alia*, to show that the proposed combination of Adamske and Tonkin teaches or suggests all of the features of the claimed inventions.

### **CLAIM 24**

With respect to claim 24, Appellants respectfully submit that the Examiner fails to show that the proposed combination of Adamske and Tonkin teaches or suggests automatically transmitting a print file for processing by a server over a network in response to generating the print file without user-initiated interaction with the server as claimed therein.

In support of the rejection, the Examiner cites fig. 8 of Adamske as allegedly teaching generating a print file on a client... as in claim 24. Appellants note that Adamske does not include a fig. 8.

Additionally, the Examiner cites col. 7, lines 32-44 of Adamske. However, Appellants note that this portion of Adamske describes actions performed "[a]fter user 10 verifies the print preview...", as part of printing the document. Adamske, col. 6, line 58; col. 7, lines 34-35. In contrast, Appellants' generating a print file is performed as part of a method of previewing a document as claimed in claim 24.

Adamske generally discusses two embodiments for a system and method for delivering an electronic document over a network.

In the first embodiment, discussed from column 4, line 61 through column 6, line 23 of Adamske, a user uploads an electronic document from a client computer to a web server using a web browser or email. Adamske, col. 5, lines 15-16. The electronic document is then converted to a portable printable format on an application translation server. Adamske, col. 5, lines 18-19. In order to perform the conversion, "the application translation program [on the application translation server] houses the variety of client applications that users use to create electronic documents." Adamske, col. 5, lines 19-21. The converted printable electronic document is then transmitted to a web server, where it is processed to create web-viewable print preview files. Adamske, col. 5, line 64-col. 6, line 3. The user can use the client-side web browser to preview the document. Adamske, col. 6, lines 12-15.

In the second embodiment, discussed from column 6, lines 24-57 of Adamske, "the client computer includes a print driver program... that is executable to convert the



electronic document and provide the print preview capability prior to uploading to the web server." Adamske, col. 6, lines 34-38. In particular, the print driver program creates a metafile from the electronic document, which provides a viewable representation of how the document will look upon printing. Adamske, col. 6, lines 46-49. Subsequently, the user "sends this metafile to [the application] translation server through web server and the conversion into a printable (e.g., PostScript) version is performed as previously described." Adamske, col. 6, lines 49-52.

Tonkin provides a web page in which a user enters a source file that includes the content to be included in a document. Tonkin, FIG. 5B, ref. 312; col. 7, lines 13-17. The source file can be a PDF file or another format, which can be first converted to PDF format. Tonkin, col. 7, line 17-27. Subsequently, image(s) of the document are generated and displayed. Tonkin, col. 12, lines 23-34.

Contrary to both embodiments of Adamske and the teachings of Tonkin, Appellants' claim 24 generates a print file on a client based on a document using a print driver executing on the client in response to a print request for the document designating the print driver, and automatically transmits the print file over a network for processing by a server in response to the generating without user-initiated interaction with the server. To this extent, prior to receiving image data on the client and displaying the image data in an interface to preview a document, a print file is generated on the client in response to a print request and transmitted for processing by a server without user-initiated interaction with the server. In contrast, in the first embodiment of Adamske and in Tonkin, the user is required to request that the document be transmitted using a web browser or by sending an email. In the second embodiment of

Adamske, the preview is performed before any communications with a server occur and before a printable version of the document is generated. In this manner, the invention of claim 24 integrates use of the server into a method of previewing a document, which does not require a user to access a website via a web browser or email a document as in Adamske and Tonkin.

In response to Appellants' arguments, the Examiner states that

Adamske et al teaches automatically user uploading or transmitting and receiving the print file to the server without user initiated interaction with the server (col. 5, lines line 64- thru col. 7, line 15, clearly once the file is received thew (sic) configuration wizard can send it to the server, no user interaction is needed).

Final Office Action, p. 4, lines 8-11.

Initially, as best understood by Appellants, the Examiner apparently alleges that a user uploading a print file to a server is performed automatically ("... teaches automatically user uploading or transmitting..."). Appellants note that, by definition, any action performed by a user in Adamske (Adamske only discusses human "users") is not automatically performed as alleged by the Examiner.

Furthermore, Appellants note that Adamske does not teach the user uploading a print file. In contrast, the user transmits either an electronic document or a metafile, both of which are later converted to a print file.

Additionally, as best understood by Appellants, the Examiner apparently alleges that communications between the application translation server and the web server of Adamske are performed without user interaction. However, Appellants note that, contrary to the invention of claim 24, such communications are not performed in response to a print file being generated on a client based on a document using a print driver executing on the client in response to a print request for the document

designating the print driver as claimed therein. Furthermore, the application translation server of Adamske does not receive and display image data as part of previewing a document as does the client in claim 24.

In light of the above-stated reasons, Appellants respectfully request reversal of the rejections of claim 24 and claims 25-28, 30-31, and 44-47, which depend therefrom, as allegedly being unpatentable over the proposed combination of Adamske and Tonkin.

#### **CLAIMS 25-27**

In the rejections of claims 25-26, the Examiner cites to figs. 5-8 of Adamske (Final Office Action, p. 4). In the rejection of claim 27, the Examiner cites to figs. 1-10 of Adamske (Final Office Action, p. 5). However, Appellants note that Adamske only includes three figures.

As a result, Appellants again request reversal of the rejections of claims 25-27 as allegedly being unpatentable over the proposed combination of Adamske and Tonkin.

#### **CLAIM 30**

With further respect to claim 30, Appellants respectfully submit that the Examiner fails to show that the proposed combination of Adamske and Tonkin teaches or suggests verifying the print driver before the transmitting step as claimed therein. In support of the rejection, the Examiner cites Adamske, col. 3, lines 47-63 as allegedly teaching this feature of the claimed invention.

However, Appellants note that this portion of Adamske merely discusses an overview of the document delivery system described therein, and does not include any teaching or suggestion of verifying a print driver as in claim 30.

Additionally, Appellants note that the Examiner apparently contends that the application of Adamske corresponds to the print driver of claim 30. However, Appellants respectfully submit that Adamske's references to client applications (Adamske, col. 5, lines 24-28) are clearly distinct from the print driver of claim 30.

As a result, Appellants again respectfully request reversal of the rejection of claim 30 as allegedly being unpatentable over the proposed combination of Adamske and Tonkin.

### **CLAIM 31**

With further respect to claim 31, Appellants respectfully submit that the Examiner fails to show that the proposed combination of Adamske and Tonkin teaches or suggests selecting file information associated with the print file using the interface as claimed therein. In support of the rejection, the Examiner cites FIG. 3 of Adamske as allegedly teaching this feature.

However, Appellants note that FIG. 3 of Adamske merely shows a web page at which a user can specify preferences regarding delivery of the hard copy document. Adamske, col. 3, lines 8-10. To this extent, FIG. 3 of Adamske does not display image data at the client as does the interface of claim 31.

As a result, Appellants again respectfully request reversal of the rejection of claim 31 as allegedly being unpatentable over the proposed combination of Adamske and Tonkin.

### **CLAIM 32**

With respect to claim 32, Appellants submit that the Examiner fails, *inter alia*, to show that the proposed combination of Adamske and Tonkin teaches or suggests a system for previewing a document that includes all the features claimed therein. For example, for reasons that should be clear from the discussion of the proposed combination of Adamske and Tonkin above, Appellants submit that the proposed combination of Adamske and Tonkin fails to teach or suggest the system of claim 32, including an upload manager for automatically transmitting a print file over a network for processing by a server in response to the print file being generated using a print driver executing on a client without user-initiated interaction with the server.

Additionally, in rejecting claim 32, the Examiner states that the claimed upload manager "reads on fig. 9 for transmitting the print file." Final Office Action, p. 5. However, Appellants note that Adamske only includes three figures.

As a result, Appellants request reversal of the rejection of claim 32 and claims 33-35, which depend therefrom, as allegedly being unpatentable over the proposed combination of Adamske and Tonkin.

### **CLAIM 36**

With respect to claim 36, Appellants submit that the Examiner fails, *inter alia*, to show that the proposed combination of Adamske and Tonkin teaches or suggests a computer program product that includes all the features claimed therein. For example, for reasons that should be clear from the discussion of the proposed combination of Adamske and Tonkin above, Appellants submit that the proposed combination of Adamske and Tonkin fails to teach or suggest program code for previewing a document that comprises program code for automatically transmitting the print file over a network for processing by a server in response to the generating without user-initiated interaction with the server. As a result, Appellants request reversal of the rejection of claim 36 and claims 37-39 and 41-43, which depend therefrom, as allegedly being unpatentable over the proposed combination of Adamske and Tonkin.

### **CLAIM 44**

With further respect to claim 44, Appellants respectfully submit that the Examiner fails to show that the proposed combination of Adamske and Tonkin teaches or suggests obtaining a selected finishing option for the document, wherein the image data is further based on the selected finishing option as claimed therein. In support of the rejection, the Examiner alleges that FIG. 3 of Adamske teaches such a feature.

However, Appellants note that FIG. 3 of Adamske merely shows a web page at which a user can specify preferences regarding delivery of the hard copy document. Adamske, col. 3, lines 8-10.

Additionally, Adamske only teaches that "the converted printable electronic document is then processed to create web-viewable print preview files for user 10 to view." Adamske, col. 6, lines 1-3 and 20-22.

Moreover, Adamske expressly discusses the selection of media options (e.g., duplex printing, paper or transparencies, color or black and white) and output handling options (e.g., stapled, bound, placed in folders or binders) "[a]fter user 10 verifies the print preview." Adamske, col. 6, lines 58-62.

As a result, Appellants again respectfully request reversal of the rejection of claim 44 as allegedly being unpatentable over the proposed combination of Adamske and Tonkin.

#### **CLAIM 45**

With further respect to claim 45, Appellants respectfully submit that the Examiner fails to show that the proposed combination of Adamske and Tonkin teaches or suggests obtaining a selected binding option for the document, wherein the image data is further based on the selected binding option as claimed therein. In support of the rejection, the Examiner alleges that FIG. 3 of Adamske teaches such a feature.

However, Appellants note that FIG. 3 of Adamske merely shows a web page at which a user can specify preferences regarding delivery of the hard copy document. Adamske, col. 3, lines 8-10.

Additionally, Adamske only teaches that "the converted printable electronic document is then processed to create web-viewable print preview files for user 10 to view." Adamske, col. 6, lines 1-3 and 20-22.

Moreover, Adamske expressly discusses the selection of output handling options (e.g., stapled, bound, placed in folders or binders) "[a]fter user 10 verifies the print preview." Adamske, col. 6, lines 58-62.

As a result, Appellants again respectfully request reversal of the rejection of claim 45 as allegedly being unpatentable over the proposed combination of Adamske and Tonkin.

#### **CLAIM 46**

With further respect to claim 46, Appellants respectfully submit that the Examiner fails to show that the proposed combination of Adamske and Tonkin teaches or suggests that the print file comprises one of: a postscript file or a Portable Document Format (PDF) file as claimed therein. In support of the rejection, the Examiner apparently alleges that the Abstract of Adamske teaches "wherein the print file comprises a postscript file." Final Office Action, p. 6 (apparently incorrectly referring to claim 47 and referencing rejection of claim 43).

However, the Adamske Abstract states that "[a] user sends the electronic document to a server over a client-server network... where a conversion software program converts the electronic document from its client application format to a printable format (e.g., a PostScript file)." Adamske, Abstract. To this extent, the Abstract of Adamske expressly teaches away from automatically transmitting a print file generated on a client over a network for processing by a server as in claim 24.



As a result, Appellants again respectfully request reversal of the rejection of claim 46 as allegedly being unpatentable over the proposed combination of Adamske and Tonkin.

#### **CLAIM 47**

With further respect to claim 47, Appellants respectfully submit that the Examiner fails to show that the proposed combination of Adamske and Tonkin teaches or suggests that the generating a print file is performed on a client without selecting a printer as claimed therein. The Examiner alleges that "the limitations of claim 47 are covered by the limitations of claim 43 above." Final Office Action, p. 6.

However, Appellants note that the feature of claim 47 ("wherein the generating is performed without selecting a printer") is unrelated to the feature of claim 43 ("wherein the print file comprises a postscript file").

Additionally, Appellants note that the Abstract of Adamske fails to teach or suggest the feature of claim 47.

As a result, Appellants again respectfully request reversal of the rejection of claim 47 as allegedly being unpatentable over the proposed combination of Adamske and Tonkin.

#### **III. Rejection of claims 29 and 40 under 35 USC § 103(a)**

Further, the Examiner rejects claims 29 and 40 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Adamske in view of Tonkin and further in view of U.S. Patent Application Publication No. 2001/0043753 (Grohs).

Initially, Appellants note that the Examiner discusses "Vidyanand" and "Cooper et al." in the rejection of claim 29, neither of which is one of the references used in the rejection.

Additionally, Appellants respectfully submit that the Examiner fails to show that each and every feature of the claimed invention is taught or suggested by the Examiner's proposed combination of Adamske in view of Tonkin and further in view of Grohs. Appellants note that the Examiner relies on its interpretation of Adamske in view of Tonkin as allegedly teaching all the features of claims 24 and 36, from which these claims respectively depend. To this extent, Appellants hereby incorporate the arguments presented above for claims 24 and 36, respectively.

Furthermore, Appellants note that the combination of Adamske, Tonkin, and Grohs, even if, *arguendo*, proper, fails to address the deficiencies of Adamske and Tonkin cited above with respect to claims 24 and 36, respectively.

As a result, Appellants request reversal of the rejections of claims 29 and 40 as allegedly being unpatentable over the proposed combination of Adamske, Tonkin, and Grohs.

#### **IV. Conclusion**

In summary, Appellants submit that independent claims 24, 32, and 36 are allowable over the cited art because the Examiner's use of Adamske, Tonkin, and/or Grohs fails to present a *prima facie* showing that each element of the claimed inventions is taught or suggested by the cited art. Additionally, Appellants respectfully submit that all other pending claims are allowable over the cited art by, *inter alia*, dependency.

Respectfully submitted,

/John LaBatt/

John W. LaBatt, Reg. No. 48,301  
Hoffman Warnick LLC  
75 State Street, 14th Floor  
Albany, NY 12207  
(518) 449-0044 - Telephone  
(518) 449-0047 - Facsimile

Dated: 23 February 2010

## CLAIMS APPENDIX

### Claim Listing:

24. A method of previewing a document, comprising:

generating a print file on a client based on the document using a print driver  
executing on the client in response to a print request for the document designating the  
print driver;

automatically transmitting the print file over a network for processing by a server  
in response to the generating without user-initiated interaction with the server;

receiving image data on the client over the network in response to the  
transmitting, the image data being based on the transmitted print file; and

displaying the image data in an interface at the client in response to the  
receiving.

25. The method of claim 24, further comprising selecting the print driver, wherein the  
selecting step includes:

displaying a list of print drivers on the client; and

choosing a desired print driver.

26. The method of claim 24, further comprising obtaining the print driver.

27. The method of claim 26, wherein the obtaining step includes transmitting the print  
driver to the client over the network.

28. The method of claim 24, further comprising creating the document using an application installed on the client.

29. The method of claim 24, further comprising compressing the print file before the transmitting step.

30. The method of claim 24, further comprising verifying the print driver before the transmitting step.

31. The method of claim 24, further comprising selecting file information associated with the print file using the interface.

32. A system for previewing a document, comprising:

a generation system for generating a print file based on the document using a print driver executing on a client in response to a print request for the document designating the print driver; and

an upload manager for automatically transmitting the print file over a network for processing by a server in response to the generating without user-initiated interaction with the server, receiving image data on the client over the network in response to the transmitting, the image data being based on the transmitted print file, and displaying the image data in an interface at the client in response to the receiving.

33. The system of claim 32, further comprising a version manager for verifying the print driver before transmitting the print file.

34. The system of claim 32, further comprising an application for creating the document, wherein the application is installed on the client.

35. The system of claim 32, wherein the network comprises one of the group consisting of a wide area network, and the Internet.

36. A computer program product comprising a computer useable medium having computer readable program code embodied therein for previewing a document, the program product comprising:

- program code for receiving a print request for the document;

- program code for generating a print file based on the document in response to the receiving;

- program code for automatically transmitting the print file over a network for processing by a server in response to the generating without user-initiated interaction with the server;

- program code for receiving image data on the client over the network in response to the transmitting, the image data being based on the transmitted print file; and

- program code for displaying the image data in an interface at the client in response to the receiving.

37. The computer program product of claim 36, further comprising program code for verifying the print driver before transmitting the print file.

38. The computer program product of claim 36, further comprising program code for creating the document.

39. The computer program product of claim 36, further comprising program code for selecting file information associated with the print file.

40. The computer program product of claim 36, further comprising program code for compressing the print file.

41. The computer program product of claim 36, further comprising program code for transmitting the print driver to the client over the network.

42. The computer program product of claim 36, further comprising program code for selecting the print driver, wherein the program code for selecting includes:

program code for displaying a list of print drivers on the client; and

program code for choosing a desired print driver.

43. The computer program product of claim 36, wherein the print file comprises a postscript file.

44. The method of claim 24, further comprising obtaining a selected finishing option for the document, wherein the image data is further based on the selected finishing option.

45. The method of claim 24, further comprising obtaining a selected binding option for the document, wherein the image data is further based on the selected binding option.

46. The method of claim 24, wherein the print file comprises one of: a postscript file or a Portable Document Format (PDF) file.

47. The method of claim 24, wherein the generating is performed without selecting a printer.



## **EVIDENCE APPENDIX**

No evidence has been entered and relied upon in the appeal.

## **RELATED PROCEEDINGS APPENDIX**

A copy of the decision on Appeal No. 2007-3345 for U.S. Application No. 09/709,433 rendered by the Board on June 16, 2008 follows.



# UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/709,433	11/13/2000	Jeff Stewart	MIME-0003	4323
23550 7590 (a)(18/29)8 HOFFMAN WARNICK LLC 75 STATE STREET 14TH FLOOR ALBANY, NY 12207				
EXAMINER CAMPBELL, JOSHUA D				
ART UNIT 2178		PAPER NUMBER		
NOTIFICATION DATE 06/18/2008		DELIVERY MODE ELECTRONIC		

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JEFF STEWART and JENNIFER R. PINCO

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Appeal 2007-3345  
Application 09/709,433  
Technology Center 2100

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Decided: June 16, 2008

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Before LANCE LEONARD BARRY, ALLEN R. MACDONALD, and  
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 12-33. Claims 1-11 have been cancelled (App. Br. 2). We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

## THE INVENTION

The disclosed invention relates generally to a system, method and recordable medium for uploading data across a network. More particularly, Appellants' invention is directed to uploading a document across the network for printing services, and configuring, ordering, and viewing the document online (Spec. 1).

Independent claim 12 is illustrative:

12. A method of previewing a document over a network, the method comprising:
  - providing system software for use on a client, wherein the system software allows a user of the client to generate a print file on the client based on the document using a local application;
  - obtaining the print file from the client on a server;
  - obtaining configuration information for the document on the server;
  - generating a preview of a configured copy of the document on the server based on the print file and the configuration information; and
  - providing the preview for display at the client.

## THE REFERENCES

The Examiner relies upon the following references as evidence in support of the rejections:

Adamske	US 6,615,234 B1	Sep. 2, 2003
Bresnan	US 5,873,073	Feb. 16, 1999

### THE REJECTIONS

Claims 12-27 and 29-33 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Adamske.

Claim 28 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Adamske in view of Bresnan.

### PRINCIPLES OF LAW

#### Obviousness under 35 U.S.C. § 103

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *Id.* at 1740. Appellants have the burden on appeal to the Board to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). Therefore, we look to Appellants’ Briefs to show error in the proffered *prima facie* case.

#### Rationale for Modification of Adamske

The Examiner has rejected all but claim 28 under 35 U.S.C. § 103 using a single reference (Adamske). The Examiner proffers that an artisan

would have been motivated to combine or otherwise modify alternate embodiments disclosed in Adamske, as follows:

Adamske does not directly disclose in this embodiment that a preview is generated by the server and provided to the user based on the print file that was uploaded. However, Adamske discloses an alternate method in which the server generates a preview based on the print file and the configuration information and provides that preview to the user for display at the client device (column 5, line 64- column 7, line 15 of Adamske). It would have been obvious to one of ordinary skill in the art to combine the two methods of Adamske because it would have allowed the client system to do less work in the process.

(Ans. 3).

In response, Appellants contend that the Examiner has improperly relied upon hindsight, as follows:

Adamske provides two embodiments for network-based document delivery. The Examiner primarily relies on the second embodiment in which the client performs some of the processing, e.g., generates a metafile and print preview. Adamske, col. 6, lines 24-57. The Examiner proposes to modify this embodiment with teachings of the first embodiment in which the client sends an electronic document to a server and displays a preview in a browser. Adamske, col. 4, line 61 -col. 6, line 23. The Examiner's motivation for the modifications is to "reduce the processing load at the client." Final Office Action, p. 12.

However, the first embodiment of Adamske (col. 4, line 61-col. 6, line 23) provides a solution in which the processing load at the client is reduced from that in the second embodiment. As a result, by its express teachings, Adamske has already addressed the motivation cited by the Examiner and teaches away from the Examiner's proposed modifications

and Appellants' claimed invention. Since proper motivation is not found in Adamske, Appellants respectfully submit that the Examiner fails to show that Adamske or the prior art provides proper motivation for the modifications proposed by the Examiner without using the hindsight of the present invention. (App. Br. 16-17).

After considering the record before us, it is our view that an artisan would have perceived the two embodiments relied on by the Examiner as being complements of each other. Courts should “take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” KSR, 127 S. Ct. at 1741. Therefore, it is our view that the teachings of Adamske would have at least suggested the claimed variation to an artisan having ordinary skill and creativity. Moreover, “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Leapfrog Enter., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (quoting KSR, 127 S. Ct. at 1739).

This reasoning is applicable here. The Examiner has merely rearranged familiar elements taught by Adamske, such as a client, a server, and a print file having associated configuration information (e.g., fonts). It is our view that the Examiner's proffered combination of such familiar elements would have yielded predictable results. Appellants have not rebutted the Examiner's legal conclusion of obviousness by showing that the claimed combination of familiar elements produces any new function. Moreover, Appellants have not provided any factual evidence of secondary considerations, such as unexpected or unpredictable results, commercial success, or long felt but unmet need. Accordingly, we find Appellants'



arguments unpersuasive that the Examiner has relied upon impermissible hindsight in modifying Adamske. We also note that Appellants do not challenge the Examiner's proposed combination of Adamske and Bresnan with respect to independent claim 28 (*see* App. Br. 20).

### FINDINGS OF FACT

The following findings of fact (FF) are supported by at least a preponderance of the evidence:

1. Adamske teaches that "web server 22 can include a print preview software program 16 . . . ." (Col. 6, ll. 4-5). Regarding Appellants' claimed "print file," Adamske teaches that "[a]pplication translation server 24 includes a conversion program 18 that is executable to read in the electronic document and convert the document to a portable printable format [print file]." (Col. 5, ll. 20-24). In one embodiment, Adamske teaches that the print file may be a PostScript format file. (Col. 5, ll. 65-66). Regarding Appellants' claimed "configuration information," Adamske teaches that font database 31 (Fig. 2) is used to facilitate the conversion. (Col. 5, ll. 46-47). Adamske clearly uses font database 31 (i.e., configuration information) to generate the preview print file.
2. Adamske teaches a shipping label (i.e., memo information) (col. 7, l. 42). Adamske teaches that "[t]he hard copy document is . . . packaged according to the user preferences defined at operational screen 70 and delivered to the user-designated

recipient(s). Optionally, the print job that produces the hard copy document can also include a print out of the packaging instructions selected by the user, a cover sheet, and a shipping label (if applicable).” (Col. 7, ll. 37-43).

3. Adamske teaches a conversion program 18 (i.e., system software) (Col. 5, ll. 21-22). Adamske teaches that “[a]pplication translation server 24 includes a conversion program 18 [i.e., system software] that is executable to read in the electronic document and convert the document to a portable printable format.” (Col. 5, ll. 21-24).
4. Adamske teaches that “[p]rint management server 28 will retrieve the converted printable (PostScript) electronic document and will send the document to the particular remote print spooler server 30 having the ID included at web server 22 via network 12. Network 12 can be the Internet or a private network connection for high traffic destinations such as an airborne courier. The print spooler server 30 prints the document at printer 40 attached locally to print spooler server 30.” (Col. 7, ll. 27-35).
5. Adamske teaches a web browser (i.e., user interface) (Col. 5, l. 15).

## ANALYSIS

After reviewing the record before us, we address arguments presented in the Briefs only to the extent that Appellant's arguments are directed to claimed subject matter. Patentability is based upon the claims. "It is the claims that measure the invention." *SRI Int'l v. Matsushita Elec. Corp. of America*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (*en banc*). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)).

We consider the following issues that flow from the contentions of the Appellants and the Examiner:

### Independent claim 12

We disagree with Appellants' contention that Adamske fails to teach the claimed generation of a preview based on anything other than a converted printable electronic document (*see* App. Br. 8, ¶1). To the contrary, we find Adamske clearly uses font database 31 (i.e., configuration information) to generate the preview print file. Therefore, we find that Adamske teaches generating a preview of a configured copy of the document on the server based on the print file and the configuration information, as claimed (*see* FF 1, *supra*). Because we conclude that Appellants have not shown the Examiner erred, we sustain the Examiner's rejection of independent claim 12 as being unpatentable over Adamske.

#### Independent claim 17

Appellants contend that Adamske fails to teach obtaining memo information that is customized for a recipient at each of a plurality of delivery addresses, let alone printing and delivering the customized memo along with the one or more copies of the document to each of the delivery addresses (App. Br. 9-10). In response, we broadly but reasonably construe the scope of the claimed “memo” as encompassing a shipping label that is customized according to the recipient’s name and address and delivered with the print job, as taught by Adamske. See FF 2, *supra*. Therefore, we find that Adamske teaches obtaining memo information (i.e., a shipping label) that is customized for a recipient at each of a plurality of delivery addresses, and printing and delivering the customized memo along with the one or more copies of the document to each of the delivery addresses, as claimed. Because we conclude that Appellants have not shown the Examiner erred, we sustain the Examiner’s rejection of independent claim 17 as being unpatentable over Adamske.

#### Independent claim 20

Regarding independent claim 20, we have fully addressed the “generating” limitations in our discussion of independent claim 12 *supra*.

Appellants further argue that “[i]n both embodiments discussed in Adamske, a printable version of the electronic document is expressly generated on an application translation server (e.g., col. 5, lines 18-19, 64- 66 and col. 6, lines 49-52) rather than by system software on a client as in the claimed invention.” (App. Br. 13).

In response, we broadly but reasonably construe a “client” as a requester of services and a “server” as a provider of services. To the extent that a client generates a print file and communicates the print file to a server, the client is providing a service (i.e., the print file) to the server. In this context, the client has become a server and the server has become a client. We restate our view that an artisan would have perceived the two embodiments disclosed by Adamske as being complements of each other. The person of ordinary skill is a person of creativity. Courts should “take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” KSR, 127 S. Ct. at 1741. Therefore, it is our view that the teachings of Adamske would have at least suggested the claimed variation to an artisan having ordinary skill and creativity.

Regarding the claimed “system software” element, we broadly but reasonably construe the scope of this term as encompassing any utility software associated with a computer system, noting that any program or utility can be included or associated with an operating system as a matter of design. Therefore, it is our view that Adamske’s conversion program 18 teaches and/or suggests “system software,” as claimed. See FF 3, *supra*. Because we conclude that Appellants have not shown the Examiner erred, we sustain the Examiner’s rejection of independent claim 20 as being unpatentable over Adamske.

Independent claim 24

We have fully addressed the “generating” limitations argued by Appellants in our discussion of independent claim 12 *supra*.

In our response for independent claim 20 we fully addressed Appellants contention that Adamske fails to teach or suggest means for obtaining a print file from a client. Again, it is our view that the teachings of Adamske would have at least suggested the claimed variation to an artisan having ordinary skill and creativity, as previously discussed.

Regarding Appellants contention that the Examiner fails to show that Adamske teaches or suggests the claimed means for assembling a copy based on configuration information, we broadly but reasonably construe the claim term “based on” as meaning “any association with.” (*See App. Br. 18*). We note that Adamske’s preview and printed copy both include fonts (i.e., configuration information). Therefore, it is our view that assembling a printed copy is reasonably “based on” fonts, because each printed page includes fonts.

Because we conclude that Appellants have not shown the Examiner erred, we sustain the Examiner’s rejection of independent claim 24 as being unpatentable over Adamske.

Independent claim 29

We have fully addressed the “generating” limitations argued by Appellants in our discussion of independent claim 12 *supra*.

In our response for independent claim 20 we fully addressed Appellants contention that Adamske fails to teach or suggest means for

obtaining a print file from a client. Again, it is our view that the teachings of Adamske would have at least suggested the claimed variation to an artisan having ordinary skill and creativity, as previously discussed.

Because we conclude that Appellants have not shown the Examiner erred, we sustain the Examiner's rejection of independent claim 29 as being unpatentable over Adamske.

#### Independent claim 31

We have fully addressed the "memo" limitations in our discussion of independent claim 12 *supra*.

It is our view that Adamske teaches the claimed "program code for obtaining a print file and configuration information communicated over a network, wherein the print file is based on the document and the print file can be directly printed by a printer" (claim 31). See FF 4, *supra*.

Because we conclude that Appellants have not shown the Examiner erred, we sustain the Examiner's rejection of independent claim 31 as being unpatentable over Adamske.

#### Independent claim 28

Regarding independent claim 28, we have fully addressed the "generating" limitations in our discussion of independent claim 12 *supra*. It is our view that Adamske teaches and/or suggests a user interface, as claimed. See FF 5, *supra*.

Regarding the Examiner's reliance on style options as teaching the claimed configuration information, it is our view that the claimed configuration information broadly but reasonably encompasses Adamske's fonts as contained in font database 31 (col. 5, ll. 47, Fig. 2). See FF1 and FF 4, *supra*. Clearly fonts can be altered (i.e., resized) using a "standard web browser," such as that disclosed by Adamske (col. 6, ll. 21-22). Therefore, we find that Adamske's web browser provides a user interface (i.e., configuration area) that enables the user to alter configuration information (i.e., fonts) in addition to previewing documents for printing (*see* Adamske, col. 6, ll. 20-22). See FF5, *supra*.

While our reading of Appellants' claims on the Adamske reference may have departed from some aspects of the Examiner's reading, it is our view that Appellants have been given full and fair notice of the Adamske reference and are responsible for all it discloses. *See In re Zenitz*, 333 F.2d 924, 926 (CCPA 1964) ("This court has held in a number of decisions that a United States patent speaks for all it discloses as of its filing date, even when used in combination with other references.")

Because we conclude that Appellants have not shown the Examiner erred, we sustain the Examiner's rejection of independent claim 28 as being unpatentable over Adamske in view of Bresnan.

Dependent claims 13-16, 18, 19, 21-23, 25-27, 30, 32, and 33

These dependent claims were not separately argued in the Briefs. Therefore, we sustain the Examiner's rejection of these claims as being unpatentable over Adamske for the same reasons discussed *supra* with



respect to representative independent claims 12, 17, 20, 24, and 29, respectively. *See* 37 C.F.R. § 41.37(c)(1)(vii).

#### CONCLUSION OF LAW

From the above discussion, we conclude that Appellant has not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner's rejections. Section 103 within Title 35 of the U.S. Code "forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR*, 127 S. Ct. at 1734 (quoting 35 U.S.C. § 103). Based on the findings of facts and analysis above, we conclude that Appellants have not met their burden of showing that the Examiner erred in rejecting claims 12-33 under 35 U.S.C. § 103(a) for obviousness.

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DECISION

We affirm the Examiner's decision rejecting claims 12-33.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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HOFFMAN WARNICK LLC  
75 STATE STREET  
14TH FLOOR  
ALBANY NY 12207